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REMARKS

This is a full and timely response to the non-final Official Action mailed July 18, 2005. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, the claims 1, 6, 7, 14 and 19 have been amended. Claims 10-13 and 23-52 were withdrawn from consideration under a previous Election of Species. Additionally, new claims 53-58 have been added. No original claims have been cancelled. Thus, claims 1-9, 14-22 and 53-58 are currently pending for the Examiner's consideration.

Allowable Subject Matter:

In the outstanding Office Action, the Examiner indicated the presence of allowable subject matter in claims 7 and 15-21. Applicant wishes to thank the Examiner for this identification of allowable subject matter.

Consequently, claims 7 and 19 have been amended herein and rewritten as independent claims. Therefore, following entry of this amendment, claims 7 and 19, and their respective dependent claims, will be in condition for allowance based on the Examiner's identification of allowable subject matter.

Applicant agrees with the Examiner's conclusion regarding the patentability of these claims without necessarily agreeing or acquiescing in the Examiner's reasoning. Applicant believes these claims to be patentable over the prior art of record because the prior art fails to

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teach or suggest the subject matter recited therein, regardless of how that subject matter might be paraphrased.

Claim Objections:

The outstanding Office Action objected to claims 1, 6 and 14 due to minor informalities. To expedite prosecution of this application, the Applicant has herein amended these claims as suggested by the Examiner in the Office Action. However, these amendments merely clarify the claim language. These amendments do not, and are not intended to, narrow or alter the scope of any claim. Following entry of this amendment, the objection to the claims should be reconsidered and withdrawn.

Drawing Objections:

The recent Office Action further objected to the drawings on the grounds that the drawings fail to illustrate the subject matter of claims 19-21. This objection is respectfully traversed because the claims illustrate the structures recited in the claims.

Claims 19 and 20 recite a plurality of pressure tuned rolling pistons. Claim 21 recites pressure tuned rolling pistons respectively providing differently colored inks. The pressure tuned rolling pistons are illustrated in Figs. 1, 2, 4, 5 and 6. The pressure tuned rolling piston providing ink is illustrated in Figs. 4 and 6.

While it is true that no single figure specifically illustrates a "plurality" of pistons or pistons containing differently colored inks, such illustrations would be redundant and are certainly not "necessary for the understanding of the subject matter sought to be patented."

37 C.F.R. § 1.81. Consequently, such illustrations are not required. For at least these reasons, the objection to the drawings should be reconsidered and withdrawn.

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Prior Art Issues--Anticipation:

Claims 1-5, 8 and 9 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,608,437 to Iwata et al. ("Iwata"). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

An ink delivery apparatus, comprising a pressure tuned rolling piston having a distal end having a pressure responsive portion; and a first convolute portion coupled to said pressure responsive portion, said first convolute portion being configured *to provide a first level of resistance against a negative pressure in said piston.* (emphasis added).

In contrast, Iwata fails to teach or suggest the claimed first convolute portion configured to provide "resistance against a negative pressure." Iwata teaches that,

[w]ith the consumption of the ink, the internal pressure reduces to produce a vacuum. The negative pressure deforms the flexible member, and bent portion advances toward the bottom plate along the inside surface of the container. At this time, the bottom portion less easily deforms than the outer wall and the inner wall, and they maintain the initial configuration while the bent portion advances. *That is the flexible member deforms irreversibly.* The ink containing volume of the ink container defined by the outer cylinder, bottom wall and the flexible member, reduces by the amount corresponding to the ink consumption. (emphasis added).

Iwata does not ever teach or suggest that the "flexible member" provides resistance against the negative pressure in the container. To the contrary, Iwata teaches that the "flexible member 2 used in this embodiment is preferably *easily deformable and soft.*" (Iwata, col. 6, lines 10-11) (emphasis added).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, because Iwata does not teach

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or suggest the claimed convolute portion that provides resistance against negative pressure in the piston, the rejection of claim 1 and its dependent claims based on Iwata should be reconsidered and withdrawn.

Prior Art Issues--Obviousness:

Claims 6, 14 and 22 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Iwata and U.S. Patent No. 5,187,498 to Burger ("Burger"). For at least the following reasons, this rejection is respectfully traversed.

Independent claim 14 recites

An ink delivery assembly, comprising:  
at least one pressure tuned rolling piston having  
a distal end having a pressure responsive portion;  
a first convolute portion supporting said pressure responsive portion, wherein *said first convolute portion is configured to provide a first level of resistance against a negative pressure in said piston;*  
a second convolute portion adjacent said first convolute portion, wherein *said second convolute portion is configured to provide further resistance against said negative pressure in said piston;*  
a proximal end opposite said distal end; and  
a fitment coupled to said proximal end of said pressure tuned rolling piston.  
(emphasis added).

Claim 6 similarly recites first and second convolute portions providing resistance to negative pressure in the piston.

As demonstrated above, Iwata fails to teach or suggest a convolute portion providing resistance to negative pressure. Burger teaches a bellows (12) that is "biased toward [a] contracted position" to create pressure on ink being expelled from the chamber (34). (Burger, abstract). Thus, Burger also fails to teach or suggest a convolute portion that resists negative pressure in the piston as claimed.

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"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejection of claims 6, 14 and 22 should be reconsidered and withdrawn.

Moreover, as demonstrated above, Iwata teaches a bent portion that "irreversibly" collapses as ink is withdrawn from a chamber. Burger teaches a bellows that squeezes ink out of a chamber. Consequently, there would be no reason why one of skill in the art would seek to combine the bellows taught by Burger with the bent portion of Iwata.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. For at least this additional reason, the rejection based on the proposed combination of Iwata and Burger is improper and should be reconsidered and withdrawn.

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Conclusion:

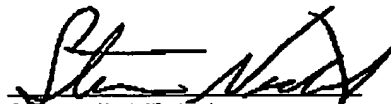
The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims.

Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 3 October 2005



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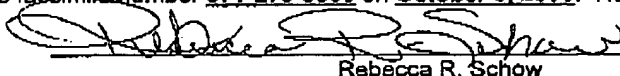
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